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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,504	04/02/2001	Charles M. Link II	BS01-020	7521

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EXAMINER

FERGUSON, KEITH

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 04/21/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/822,504

Applicant(s)

LINK II ET AL.

Examiner

Keith T. Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 15-18 and 27-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-14 and 19-26 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>9</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14 and 19-26, drawn to a method for transmitting a message over a wireless network, classified in class 455, subclass 422.1.
- II. Claims 15-18, drawn to a method for transmitting a advertisement over a wireless network, classified in class 455, subclass 456.1.
- III. Claims 27-31, drawn to a system for transmitting messages over a wireless network comprising an advertisement queue, classified in class 455, subclass 456.5.
- IV. Claims 32-33, drawn to an internet website for enabling an advertiser to generate request for transmission of advertisement, classified in class 455, subclass 426.1.
- V. Claims 34-35, drawn to an internet web site for enabling users of wireless communication devices to register to receive advertisement, classified in class 455, subclass 435.1.

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The inventions are distinct, each from the other because of the following reasons:

2. Inventions I, II, III, IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions * I, II, III, IV and V have different modes of operation.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Micheal Oblon on April 15, 2004 a provisional election was made without traverse to prosecute the invention of group I, claims 1-14 and 19-26. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-18 and 27-35 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3,6-9,11-13,19-21 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Neil.

The claimed invention reads on O'Neil as follow:

Regarding claims 1 and 2, O'Neil discloses a method (fig.7, fig.8 and fig. 9) for transmitting a message over a wireless network to a wireless communications device (paragraph 0003 line 1 through paragraph 0005 line 6), said method comprising the steps of: (a) storing a plurality of messages (advertisements or merchant data) in a database (paragraph 0027 lines 1-17), wherein each stored message is associated with one or more locations paragraph 0027 lines 1-17; (b) detecting location information of a wireless communications device (paragraph 0041 line 1 through

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paragraph 0043 line 12); (c) selecting a message in the database associated with the detected location (paragraph 0043 lines 1-12); and (d) transmitting the selected message to the wireless communications device (paragraph 0047 lines 1-32).

Regarding claim 3, O'Neil discloses each of the plurality of messages stored in the database contains advertising information sponsored by a respective advertiser having a place of business within a proximity of the location associated with the message (paragraph 0027 line 1 through paragraph 0028 line 4).

Regarding claim 6, O'Neil discloses paper media (text) and voice mail (audio information).

Regarding claim 7, O'Neil discloses the wireless communications device is a cell phone (paragraph 0039 lines 1-10) and a automotive navigational system (paragraph 0058 lines 1-6).

Regarding claim 8, O'Neil discloses each of the messages stored in the database is also associated with one or more demographic codes (merchant ID, name, location, IP address etc.) (fig. 3 number 250), each wireless communications device operating in the wireless network is associated with one more demographic codes (fig. 3 numbers 230, 250 and 270 and paragraph 0034 lines 1-24 and paragraph 0037 lines 1-10), and wherein the message selected to be transmitted is associated with at least one demographic code associated with the identified wireless communications device in addition to being associated with the detected location (paragraph 0034 lines 1-24 and paragraph 0037 lines 1-10 and paragraph 0046 lines 1-32).

Regarding claim 9, O'Neil discloses a method (fig. 7, fig. 8, fig. 9) for transmitting an advertisement over a wireless network to a wireless communications device (paragraph 0003 through paragraph line 6), said method comprising the steps of: (a) storing a plurality of advertisements in an advertisements database (paragraph 0027 lines 1-17), wherein each advertisement is requested to be transmitted to wireless communications devices by a respective advertiser (paragraph 0027 line 1 through paragraph 0028 line 4), and each advertisement is associated with

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one or more locations (paragraph 0028 line 4) and category codes (key words); (b) storing information pertaining to a plurality of wireless communications devices in a devices database (paragraph 0032 lines 1-14), wherein each wireless communications device is associated with identification data (paragraph 0032 lines 1-14) and category codes (preferences) (paragraph 0032 lines 1-14); (c) storing in an advertisers database a list of advertisers requesting transmission of advertisements stored in the advertisements database (paragraph 0034 lines 1-24), wherein each advertiser is associated with advertiser account information (willing to pay) (paragraph 0038 lines 4-5); (d) detecting the presence of the wireless communications device in a location (paragraph 0041 line 1 through paragraph 0043 line 12); (e) detecting an identification of the wireless communications device (paragraph 0041 line 1 through paragraph 0043 line 12); (f) selecting an advertisement in the database associated with the detected location and associated with at least one category code (preference) associated with the wireless communications device in the devices database (paragraph 0047 lines 1-32); and (g) transmitting the selected advertisement to the wireless communications device (paragraph 0047 lines 1-32).

Regarding claim 11, O'Neil discloses wherein advertisers access the advertisers database to add requests to transmit advertisements through an Internet web page (paragraph 0038 lines 1-13).

Regarding claim 12, O'Neil discloses wherein users of wireless communications devices access the devices database to select from one or more category codes that correspond to the users' preferences for receiving advertisements (user specifies a delivery preference) (paragraph lines 13-15).

Regarding claim 13, O'Neil discloses the advertisements database is automatically created from requests to transmit advertisements stored in the advertisers database (paragraph 0034 lines 1-20).

Regarding claim 19, O'Neil discloses a method (fig. 7, fig. 8, and fig. 9) for transmitting advertisements over a wireless network to wireless communications devices (paragraph 0003 through paragraph line 6), the wireless network in communication with an advertisements database containing a plurality of advertisements (paragraph 0027 lines 1-17 and paragraph 0034

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lines 1-24) and a users database (paragraph 0032 lines 1-14) containing identification data of a plurality of wireless communications devices (paragraph 0032 lines 1-14), and wherein the advertisements and the identification data are each associated with at least one category code (preference) (paragraph 0032 lines 1-14), said method comprising the steps of: (a) detecting identification information of a wireless communications device operating in the wireless network (paragraph 0041 line 1 through paragraph 0043 line 12); (b) selecting an advertisement in the database associated with at least one category code (preference) that is associated with the wireless communications device in the users database (paragraph 0047 lines 1-32); and (c) transmitting the selected advertisement to the wireless communications device (paragraph 0047 lines 1-32).

Regarding claim 20, O'Neil discloses the category code indicates a category (delivery preference) pertaining to a service associated with a respective advertisement (paragraph 0047 lines 1-32).

Regarding claim 21, O'Neil discloses wherein the category codes associated with wireless communications devices indicates users' preferences in receiving advertisements (i.e. delivery preference) (paragraph 0047 lines 1-32).

Regarding claim 25, O'Neil discloses the wireless communications device is operating on the wireless network in a cell location that is associated with the selected advertisement (inherent, when a cell phone is in communication with an advertisement server, as taught in paragraph 0039 lines 1-8).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at

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the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 14,23,24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil in view of Mankoff.

Regarding claim 14, O'Neil discloses a method as discussed supra in claim 9 above. O'Neil differs from claim 14 of the present invention in that it does not disclose wherein the advertisements contain coupons to be redeemed with the respective advertiser. Mankoff teaches advertisements contain coupons to be redeemed with respective advertiser (paragraph 0008 lines 1-26). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made To modify O'Neil method with wherein the advertisements contain coupons to be redeemed with the respective advertiser in order for the cell phone to receive a discount when purchasing goods from a nearby merchant, as taught by Mankoff.

Regarding claims 23 and 24, O'Neil discloses a method as discussed supra in claim 19 above. O'Neil differs from claims 23 and 24 of the present invention in that it does not disclose transmitting coupons over a wireless network to a wireless communication device, a database for storing a plurality of coupons associated with advertisers; receiving response information from the wireless communications device; and providing response information to the advertiser. Mankoff teaches transmitting coupons over a wireless network to a wireless communication device (paragraph 0008 lines 1-26), a database for storing a plurality of coupons associated with advertisers (paragraph 0024 lines 1-22); receiving response information (coupon redeemed) from the wireless communications device (paragraph 0008 lines 1-26); and providing response information (coupon redeemed) to the advertiser (paragraph 0008 lines 1-26). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made To modify O'Neil wireless network with transmitting coupons over a wireless network to a wireless communication device, a database for storing a plurality of coupons associated with advertisers; receiving response information from the wireless communications device; and providing response information to the advertiser in order for the user of the IP terminal receive discounts on select

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merchandise from nearby merchants, to provide discount coupons to travelers in proximity of the merchants, and redeemed the coupon for a cheaper price at a nearby restaurant, as taught by Mankoff.

Regarding claim 26, O'Neil discloses a method (fig. 7, fig. 8, and fig. 9) for transmitting advertisements over a wireless network to wireless communications devices (paragraph 0003 through paragraph line 6), the wireless network in communication with an advertisements database containing a plurality of advertisements (paragraph 0027 lines 1-17 and paragraph 0034 lines 1-24) and a users database (paragraph 0032 lines 1-14) containing identification data of a plurality of wireless communications devices (paragraph 0032 lines 1-14; said method comprising the steps of: detecting identification information of a wireless communications device operating in the wireless network (paragraph 0041 line 1 through paragraph 0043 line 12); transmitting the selected advertisement to the wireless communications device (paragraph 0047 lines 1-32). O'Neil differs from claim 26 of the present invention in that it does not explicit disclose transmitting coupons over a wireless network to a wireless communication device, a database for storing a plurality of coupons associated with advertisers; receiving response information from the wireless communications device; and providing response information to the advertiser. Mankoff teaches transmitting coupons over a wireless network to a wireless communication device (paragraph 0008 lines 1-26), a database for storing a plurality of coupons associated with advertisers (paragraph 0024 lines 1-22); receiving response information (coupon redeemed) from the wireless communications device (paragraph 0008 lines 1-26); and providing response information (coupon redeemed) to the advertiser (paragraph 0008 lines 1-26). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made To modify O'Neil wireless network with transmitting coupons over a wireless network to a wireless communication device, a database for storing a plurality of coupons associated with advertisers; receiving response information from the wireless communications device; and providing response information to the advertiser in order for the user of the IP terminal receive discounts on select merchandise from nearby merchants, to provide discount coupons to travelers in proximity of the merchants, and redeemed the coupon for a cheaper price at a nearby restaurant, as taught by Mankoff.

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9. Claims 4 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil in view of Hendrey et al..

Regarding claim 4, O'Neil discloses a method as discussed supra in claims 1 and 2 above. O'Neil differs from claim 4 of the present invention in that it does not disclose the wireless communications device is associated in the database with a field indicating whether to block the transmission of messages to the wireless communications device, whereby messages that are associated in the database with a field indicating to block the transmission of messages are not transmitted to the wireless communications devices. Hendrey et al. teaches the wireless communications device is associated in the database with a field indicating whether to block the transmission of messages to the wireless communications device (paragraph 0037 lines 8-13), whereby messages that are associated in the database with a field indicating to block the transmission of messages are not transmitted to the wireless communications devices (paragraph 0037 lines 8-13). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify O'Neil method with the wireless communications device is associated in the database with a field indicating whether to block the transmission of messages to the wireless communications device, whereby messages that are associated in the database with a field indicating to block the transmission of messages are not transmitted to the wireless communications devices in order to prevent advertisements from merchants during dinner time, as taught by Hendrey et al..

Regarding claim 22, O'Neil discloses a method as discussed supra in claim 19 above. O'Neil differs from claim 22 of the present invention in that it does not disclose the wireless the category code indicates a category pertaining to a time period, wherein different advertisers prefer to have advertisements transmitted during different particular time periods, and wherein different users prefer to have advertisements transmitted during different particular time periods. Hendrey et al.. teaches a category code indicates a category pertaining to a time period (paragraph 0032 lines 1-21), wherein different advertisers prefer to have advertisements transmitted during different particular time periods (paragraph 0032 lines 1-21), and wherein different users prefer to have advertisements transmitted during different

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particular time periods (paragraph 0032 lines 1-21). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify O'Neil with the wireless the category code indicates a category pertaining to a time period, wherein different advertisers prefer to have advertisements transmitted during different particular time periods, and wherein different users prefer to have advertisements transmitted during different particular time periods in order to tailor the merchant advertisement based upon the time period that the IP terminal would respond, and not waste advertisement resources by continuing sending advertisements, as taught by Hendrey et al..

10. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil in view of Wolfe et al..

Regarding claim 10, O'Neil discloses a method as discussed supra in claim 9 above. O'Neil differs from claim 9 of the present invention in that it does not disclose updating the advertiser account information of the advertiser requesting transmission of the selected advertisement. Wolfe et al. teaches updating the advertiser account information of the advertiser requesting transmission of the selected advertisement (col. 4 lines 47-54). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify O'Neil with updating the advertiser account information of the advertiser requesting transmission of the selected advertisement in order to bill the merchant for new advertisements being sent to the IP terminal, as taught by Wolfe et al..

Allowable Subject Matter

11. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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12. The following is a statement of reasons for the indication of allowable subject matter: Regarding claim 5, the prior art of record fails to teach or suggest, alone or in combination the steps of: (e) storing messages to be transmitted to wireless communications devices in a pending database; (f) transmitting a message stored in the pending database over a forward control channel to a wireless communications device; (g) receiving an acknowledgement from the wireless communications device of receipt of the transmitted message over a reverse control channel; (h) deleting the transmitted message from the pending database; and (i) storing a confirmation of the transmitted message in an account associated with the respective advertiser sponsoring the message.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith T. Ferguson whose telephone number is (703) 305-4888. The examiner can normally be reached on 6:30am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (703) 308-5318. The fax phone number for the

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organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Keith Ferguson 
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April 16, 2004